Appln. No.: 09/748,995
Amdt. Dated January 4, 2005
Reply to Office Action dated October 5, 2004

REMARKS

I. Status of the Claims:

Claims 5, 7 and 8 are pending in the application. In the Office Action dated October 5, 2004, claims 5, 7 and 8 stand rejected under 35 U.S.C. §112 as indefinite and also stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,119,051 to Anderson, Jr., et al. ("Anderson").

II. Claim Rejections Under 35 U.S.C. §112

In the Office Action dated October 5, 2004, claims 5, 7 and 8 were rejected under 35 U.S.C. §112 as indefinite in connection with the recital of "the mailer's legacy computer" on line 4 (sic) of claim 5. The word "legacy" has been deleted from the identified recital. Applicant submits that this rejection is now moot and may be withdrawn.

III. Claim Rejections Under 35 U.S.C. §103(a)

Claims 5, 7 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,119,051 to Anderson, Jr., et al. ("Anderson").

Inherency Argument

In the Office Action, the Examiner admits that Anderson does not disclose steps relating to "interpolating the printstream." It is believed that the Examiner is referring to the steps of:

interpolating the printstream in the work
station computer to generate one or more Mail Run
Data Files (MRDF) in an appropriate format for each

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of the different proprietary control systems and
containing piece level data for the mail pieces that
are to be assembled in the plurality of inserter
systems; and

providing the one or more Mail Run Data Files
to the plurality of inserter systems interpolating the
Mail Run Data Files for operation of each inserter
system interpolating the Mail Run Data Files.

In particular, the Examiner has alleged that "the generation of a database
in one computer, transmittal of that database to a second (or successive)
computer, and recreation of that database in a form that can be printed
inherently implies interpolation of the database from an electronic format to a
printable format." As a preliminary matter, the Examiner does not cite any
support in Anderson for this alleged inherent subject matter, and the chain of
reasoning cannot be followed. Secondly, even if the logic of the argument
made sense, or was supportable, the conclusion of the alleged inherency of
"interpolation of the database from an electronic format to a printable format"
does not correspond to the features of claim 5, as recited above, that were
admittedly missing. Thus the alleged inherency argument is insufficient to
support the § 103 rejection and Applicants traverse this allegation of inherency
and request that it be withdrawn.

Official Notice Argument

The Examiner has relied on the Official Notice of "transmitting of data
from one computer to another in order to perform different functions at a remote
computer or a workstation,"

Applicant traverses the Examiner's Official Notice as applied to the rejected claims. Even if the Official Notice is a correct statement, it is insufficient to disclose or suggest all of the limitations of the rejected claims.

As background for this traversal, it should be noted that the legacy computer systems for use with the invention have less flexibility than the computers that are assumed in the Official Notice. As stated in the specification of this application, and in the amended preamble of claim 5, the invention is directed to a method that does not require alteration of the mailer's legacy computer system. The legacy computer systems are typically old mainframes that are difficult or costly to add new functionality to. See page 2, line 11, to page 3, line 2, and page 6, lines 8-16 of the present application.

As seen in Fig. 1A of the present application, a legacy system may be configured to output the print stream, and an Mail Run Data File (MRDF) for a particular type of inserter system. This prior art arrangement works adequately when the particular type of inserter system is used, but a problem arises if the mailer wants to use other types of inserter systems not originally contemplated. The other types of inserters cannot use the MRDF generated by the legacy system, and might not be able to achieve full functionality when preparing mail for the legacy systems.

In particular, the problem of multiple types of inserters may appear if the mailer chooses to use the services of a third party mail production facility that has multiple types of inserters. In order to fully utilize such a third party mail production facility, the present invention provides flexibility without requiring special data from the legacy system.

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Thus, the present invention is more than a mere substitution of work at one computer for another. Rather, by specifiying the type of data to be transferred ("print stream data"), where it is to be transferred ("the workstation computer") and by specifying what to do with the print stream data (the "interpolating" steps), the present invention provides non-obvious flexibility and functionality to assist mailers with legacy computers that have this problem. The Official Notice relied upon by the Examiner does not provide the disclosure of what data is to be transferred, where it is to be transferred, or how it is to be processed in order to achieve the desired functionality without altering the legacy computer systems.

Preamble Argument

The Examiner has noted that the preamble includes a recital of "each of the plurality of inserter systems having different proprietary control systems" and asserted that the recited feature is not positively recited or provided for in the claims. To the contrary, the "interpolating" step states "interpolating the printstream in the work station computer to generate one or more Mail Run Data Files (MRDF) in an appropriate format for each of the *different proprietary control systems* and containing piece level data for the mail pieces that are to be assembled in the plurality of inserter systems."

Accordingly, the examiner should give full weight to the method steps directed to steps relating to "different proprietary control systems."

VI. Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that all the issues identified by the Examiner have been addressed

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PAGE 9/10 * RCVD AT 1/4/2005 2:06:19 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:203 924 3919 * DURATION (mm-ss):02-40

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and that the claims of this application are now in a condition for allowance.

Favorable action on this application is requested.

Respectfully submitted,

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